

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALAIN BETHUNE and SOPHIE HELENE VAYRETTE

Appeal 2006-2052
Application 09/506,795
Technology Center 1700

Decided: September 26, 2006

Before KRATZ, TIMM, and JEFFREY T. SMITH, *Administrative Patent Judges*.

JEFFREY T. SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicants appeal the rejection of claims 1 to 6, 8 to 10, 12, 14, 16, 20 to 26, 28 to 35, 73, and 76. Claims 7, 11, 13, 15, 17, 18, 19, and 72 are withdrawn from consideration. (Br. 3). We have jurisdiction under 35 U.S.C. § 134.¹

¹ An Oral Hearing took place on September 14, 2006.

We REVERSE.

BACKGROUND

The appealed invention relates to a method of applying pieces of material to objects, such as bottles and other forms of packaging (Specification 1). Representative claims 1 and 76, as presented in the Brief, are reproduced below.

1. A method of applying pieces of material to objects, the method comprising:

providing a material supply strip and at least one applicator device capable of applying material from said supply strip to objects, said supply strip initially including a backing having first and second opposing surfaces and pieces of material removably arranged on both of the first and second surfaces, the backing and the pieces of material being formed of substantially the same material, wherein the pieces of material on the first surface have a different size than the pieces of material on the second surface, and wherein the pieces of material on the first surface are centered with respect to corresponding pieces of material on the second surface;

applying at least one piece of material from the first surface of the backing to at least one object with said at least one applicator device; and

applying at least one piece of material from the second surface of the backing to at least one object with said at least one applicator device.

76. A method of applying pieces of material to objects, the method comprising:

providing a material supply strip and at least one applicator device capable of applying material from said supply strip to objects, said supply strip initially including a backing having first and second opposing surfaces and pieces of material removably arranged on both of the first and second surfaces, the pieces of material on the first surface having a different size than the pieces of material on the second surface, wherein the pieces of material on the first surface are centered with respect to corresponding pieces of material on the second surface;

applying at least one piece of material from the first surface of the backing to at least one object with said at least one applicator device; and
applying at least one piece of material from the second surface of the backing to at least one object with said at least one applicator device.

The Examiner relies on the following references in rejecting the
appealed subject matter:

Schafer	DE 2,212,995	Sep. 27, 1973
Wochner	US 3,861,986	Jan. 21, 1975
Moncrieff Baldwin	US 5,143,466	Sep. 01, 1992
Iwao	JP 05-294054	Sep. 11, 1993
Amano	US 5,376,417	Dec. 27, 1994
Hirose	US 5,569,540	Oct. 29, 1996
Brandt	US 6,379,761 B1	Apr. 30, 2002
Stocq	US 6,306,475 B1	Oct. 23, 2001

Claims 1 to 26, 28 to 35, 72, 73, and 76 stand rejected under
35 U.S.C. § 112, ¶ 1, as containing subject matter which was not described
in the original Specification in such a way as to reasonably convey that
Appellants were in possession of the invention now claimed at the time of
filing (Answer 3);

Claims 1 to 5, 8 to 10, 12, 14, 21, 28, 73, and 76 stand rejected under
35 U.S.C. § 103(a) as unpatentable over the combined teachings of Schafer,
Stocq, and Iwao (Answer 3 to 7);

Claim 6 stands rejected under 35 U.S.C. § 103(a) over the combined
teachings of Schafer, Stocq, Iwao, and Moncrieff Baldwin (Answer 7);

Claims 16, 20, and 34 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Schafer, Stocq, Iwao, and Wochner (Answer 8);

Claims 22, 24 to 26, and 29 to 34 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Schafer, Stocq, Iwao, and Brandt (Answer 8 and 9);

Claims 23 and 35 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined teachings of Schafer, Stocq, Iwao, and Amano (Answer 9);

Claim 28 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Schafer, Stocq, Iwao, Brandt, and Hirose (Answer 10).

Based on the totality of the record, we reverse all of the aforementioned rejections. In rendering this decision we have considered the Appellants' arguments presented in the Briefs filed February 22, 2005 and March 10, 2006. We have also considered the Examiner's position presented in the Answer mailed January 17, 2006.

OPINION

Rejection Under § 112, ¶1

The Examiner finds that Appellants' independent claims, 1 and 76, contain the phrase "the pieces of material on the first surface have a different size than the pieces of material on the second surface" does not have basis in the original disclosure or the priority document (Answer 3). Appellants argue that the Specification at page 14 provides basis for the claimed phrase. (Answer 5).

An *ipsis verbis* disclosure is not necessary to satisfy the written description requirement of § 112. Instead, the disclosure needs only to reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question. *See In re Edwards*, 568 F.2d 1349, 1351-52, 196 U.S.P.Q. 465, 467 (C.C.P.A. 1978). The Specification on page 14 as originally filed clearly discloses that the invention can be practiced with labels having different configurations including different sizes. It is our opinion that this disclosure conveys to a person of ordinary skill in the art that Appellants had possession of the invention as presently claimed. Consequently, the Examiner's rejection is reversed.

Now we turn to the prior art rejections.

Rejections Under § 103(a)

In rejecting the subject matter of the independent claims 1 and 76, the Examiner relies on the Schafer, Stocq, and Iwao references. The subject matter of claims 1 and 76 specify that the pieces of material on the first and

second surfaces have a different size, and that the pieces of material on the first surface are centered with respect to the corresponding pieces of material on the second surface.

The method of applying pieces of a material described by Schafer employs a strip that comprises a backing having material on the first and second opposing surfaces. According to the Examiner, Schafer discloses that it is known to use labels of different shapes on opposing surfaces (Answer 4). The Examiner recognizes that Schafer does not disclose that the pieces of material on the first surface and second surfaces of the supply strip are centered relative to each other. (*Id.*). The Examiner cites the Iwao reference for disclosing that the centering of pieces of material on the first and second surfaces of a supply strip relative to each other was known by persons of skill in the art (Answer 5). The Examiner cites the Stocq reference for teaching the composition of the materials used in the formation of the supply strip and backing material.

Appellants argue that Schafer does not disclose that the pieces of material are centered relative to one another (Br. 15). Appellants further argue that Schafer discloses a double-sided label strip with a staggered configuration and specially-designed feed device to process a strip with a staggered configuration (Br. 17). Appellants further argue that Iwao does not provide a suggestion or motivation to modify Schafer to abandon its staggered configuration or to use a centered configuration with material pieces of different sizes (Br. 17). We agree.

The Iwao reference appears to describe in Fig. 3 that the labels are placed on each side of the strip opposing one another. These labels also appear to be of similar shape and size. It can not be conclusively determined from the depiction in Figure 3 that the opposing pieces of material are centered relative to the corresponding opposing piece. The Examiner recognizes that Iwao is concerned with labels of similar size (Answer 12). The Examiner does not address the Appellants' position that the pieces of material in Schafer are staggered and would require modification to Schafer's invention to dispense double-sided labels such as those disclosed by Iwao. As such, the Examiner has not established a prima facie case of obviousness.

The Examiner relies on additional references for disclosing the features of the dependent claims. These references do not address the deficiency we noted in the Examiner's rejection above.

For the foregoing reasons, we determine that the Examiner has failed to establish a prima facie case of unpatentability in view of the cited prior art references. Therefore, we reverse all rejections based on prior art in this appeal.

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Conclusion

The rejection of the claims under 35 U.S.C. § 112, ¶ 1, for failing to fulfill the written description requirement is reversed. The rejections of the appealed claims under 35 U.S.C. § 103(a) are reversed.

REVERSED

clj

Finnegan, Henderson, Farabow, Garrett & Dunner LLP
901 New York Avenue, N.W.
Washington, DC 20001-4413